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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,825	05/21/2004	Nadia Gardel	119740	8388

25944 7590 08/06/2007  
OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER
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HOFFER, SUSANNA MARIE

ART UNIT	PAPER NUMBER
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1609

MAIL DATE	DELIVERY MODE
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08/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/849,825

Applicant(s)

GARDEL ET AL.

Examiner

Susanna Hoffer

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) 31-39, 43-47, 86-94, 98-102 and 104 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30, 40-42, 48-85, 95-97 and 103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :5/21/2004, 1/24/2006, 3/16/2006, 7/27/2006.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-30, 40-42, 48-85, 95-97 and 103, in the reply filed on July 18, 2007 is acknowledged. The traversal is on the ground(s) that there is no search burden on the examiner in the examination of 104 claims and that the examiner errs in asserting that the subject matter of Groups I-VI are mutually exclusive. This is not found persuasive because the different inventions are drawn to using differing compounds. These compounds are distinct and have different functional properties and activities. A search for any of the compounds is not required for the others.

Thus claims 31-39, 43-47, 86-94, 98-102, and 104 are withdrawn from consideration as being drawn to non-elected subject matter.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-30, 40-42, 48-85, 95-97, and 103 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-30, 40-42, 48-85, 95-97, and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. (US 5,843,417) in view of Bara (US 5,919,468).

Hanna et al. teach a water-in-oil (W/O) emulsion, wherein the oil is preferably a C10-C14 saturated, linear, or branched hydrocarbon such as isododecane (col. 1, lines 49-54). Oils such as isododecane are present in an amount from 10-55% and water is preferably present in an amount from 37-45% (col. 2, line 62; col. 2, line 38). The emulsion contains one or more surfactants such as dimethicone copolyol, lauryl methicone copolyol, and cetyl dimethicone copolyol (claim 72) in an amount of 5-15% (col. 5, lines 3-5). The W/O emulsion preferably contains a water-soluble and/or water-dispersable polymer (col. 2, lines 4-6). The object of the invention is to provide cosmetic products, which may be used on the skin as a liquid foundation, concealer, or a blush (col. 1, lines 34-35). The patented invention may also contain other oils commonly used in cosmetic emulsions such as silicone oils, including volatile silicone oils such as linear and cyclic silicone oils (col. 3, lines 33-35) and does not contain cyclotetrasiloxane.

Hanna et al. do not teach the use of polymethyl methacrylate particles and their densities or relative densities. Although Hanna et al. teach the use of silicone oils, they do not specifically name the silicone oils of claim 27.

Bara teaches a composition that can be a W/O emulsion containing filler such as polymethyl methacrylate (col. 3, line 58; col. 4, lines 1-3). The composition also comprises silicone oils, one of which may be decamethylcyclopentasiloxane (col. 3, line 42).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include fillers such as polymethyl methacrylate particles in the skin make-up composition of Hanna et al. because these particles modify the texture of the formulations (see Bara (col. 3, lines 66-67)). It would have also been obvious to a person of ordinary skill in the art at the time the invention was made to include decamethylcyclopentasiloxane as the preferred silicone oil because it is a silicone oil known to be used in W/O emulsions for skin make-up and is not harmful to humans. Lastly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine the densities and percentages at which the particles of polymethyl methacrylate are most effective. The result-effective adjustment in conventional working parameters (e.g., determining the appropriate particle densities, relative densities and weight percentages within the composition) is deemed merely a matter of judicious selection and routine optimization, which is well within the purview of the ordinary artisan.

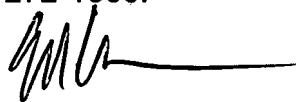
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna Hoffer whose telephone number is (571)272-9345. The examiner can normally be reached on Monday - Friday, 9:00 a.m.-5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker can be reached on (571)272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMH



**MICHAEL MELLER**  
**PRIMARY EXAMINER**